

REMARKS

By this Amendment, claims 1, 13, 15, 16 and 25 are amended, and claims 7 and 14 are canceled, without prejudice to or disclaimer of the subject matter found therein. No new matter is added. Accordingly, claims 1-6, 8-13 and 15-29 are pending in this application. Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments add features previously recited in dependent claims; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Allowable Subject Matter

Applicant gratefully acknowledges that the Office Action indicates that claims 14-17 and 19 include allowable subject matter.

Claim 13 is amended to incorporate all features of claim 14, and thus is also allowable. Claims 15 and 16 are amended solely to depend from claim 13, and thus are also allowable. Claims 17-25, 28 and 29 also depend from claim 13, and thus also are allowable.

II. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claim 25 under 35 U.S.C. §112, second paragraph, as indefinite. Claim 25 is amended to clarify that two or more separation mechanisms of claim 23 are being claimed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 1, 3-9, 11-13, 18, 21, 23, 24, 26 and 28 under 35 U.S.C. §102(b) over U.S. Patent No. 4,606,535 to Larson. The rejection is moot with respect to canceled claim 7 and respectfully traversed with respect to claims 1, 3-6, 8, 9, 11-13, 18, 21, 23, 24, 26 and 28.

As discussed above, claim 13 is amended to incorporate all features of allowable claim 14. Therefore, claims 13 and dependent claims 18, 21, 23, 24 and 28 are patentable over Larson.

Independent claim 1 is amended to incorporate all features of claim 7. Larson does not teach or suggest a paper feed apparatus including an inclined surface provided in the given convey path such that the inclined surface makes an obtuse angle relative to the paper stored in the paper storage and in which "the plurality of projections project from the inclined surface through the elongated hole," as recited in independent claim 1.

The Office Action asserts that Larson teaches, in Figs. 3-7, a sheet feeding device including an inclined portion 76, 80, 98 having an elongated hole in which projections 70 project. See Office Action pages 3-4. Notwithstanding these assertions, Larson does not teach or suggest a plurality of projections projecting from an inclined surface, as set forth in claim 1.

Larson teaches, in Fig. 3, a sheet feeding device including a tray 90 for supporting a stack 82 of sheets. The lowermost portions of the stack 82 may rest on a retard device 56 that includes a plurality of retard members 58, 60, 62, 64, 66, 68 each pivotally mounted on an axles 71, 71A and each having one retard shoe 70 positioned at an end thereof. See Figs. 3-7, col. 4, lines 7-18, and col. 5, lines 44-50. The plurality of retard members 58, 60, 62, 64, 66, 68 and the retard shoes 70 may project from an opening in a trailing end 80 of a bail weight 76. See Fig. 3, and col. 4, lines 19-23.

Larson teaches that the trailing end 80 is parallel to the stack 82 stored in the tray 90. However, Larson does not teach or suggest that the trailing end 80 forms an obtuse angle in a conveying direction relative to the stack 82 stored in tray 90. See Fig. 3. Therefore, Larson does not disclose, teach or suggest a plurality of projections projecting from an inclined surface that makes an obtuse angle relative to the paper stored in the paper storage, as set forth in claim 1.

For at least the reasons discussed above, claims 1 and 13 are patentable over Larson. Claims 1, 3-9, 11, 12, 18, 21, 23, 24, 26 and 28 variously depend from claims 1 and 13, and thus also are patentable over Larson for at least the reasons discussed above, as well as for the additional features they recite.

IV. Rejection Under 35 U.S.C. §102(e)

The Office Action rejects claims 1, 4-6, 8, 11-13, 18, 21, 23, 24 and 26-28 under 35 U.S.C. §102(e) over U.S. Patent No. 6,942,209 to Kawakami. Applicant respectfully traverses the rejection.

As discussed above, claim 13 is amended to incorporate all features of allowable claim 14. Therefore, claims 13 and dependent claims 18, 21, 23, 24 and 26-28 are patentable over Kawakami.

Kawakami does not teach or suggest a paper feed apparatus including an inclined surface "provided with an elongated hole formed along the conveying direction of the paper" and in which "the plurality of projections project from the inclined surface through the elongated hole," as recited in independent claim 1.

Kawakami teaches, in Figs. 4-9, a sheet feeding apparatus 2 including a feeding roller 4 and a separation pad unit 6 for conveying sheets P. The separation pad unit 6 includes a separation pad 6a having a separation pad surface 6c that includes a plurality of three-dimensional structural bodies 6d positioned on the separation pad surface 6c. See Figs. 4-9.

However, Kawakami does not teach or suggest that the separation pad surface 6c is provided with an elongated hole formed along a conveying direction of the sheets P. T

Because Kawakami does not teach or suggest an elongated hole provided in the separation pad 6a, Kawakami cannot reasonable be considered to teach or suggest that the plurality of three-dimensional structural bodies 6d project from the separation pad 6a through an elongated hole. Therefore, Kawakami does not teach or suggest the paper feed apparatus of claim 1.

For at least the reasons discussed above, claims 1 and 13 are patentable over Kawakami. Claims 4-6, 8, 11, 12, 18, 21, 23, 24 and 26-28 variously depend from claims 1 and 13, and thus also are patentable over Kawakami for at least the reasons discussed above, as well as for the additional features they recite.

V. Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 2 and 22 under 35 U.S.C. §103(a) over Larson or Kawakami; and rejects claims 10 and 20 under 35 U.S.C. §103(a) over Larson. Applicant respectfully traverses the rejections.

A. Claims 2 and 22

The Office Action also indicates that both Larson and Tanaka disclose the claimed invention except for an arm portion and paper separation unit being made of metal. However, Applicant believes that the indication of Tanaka is in error because (1) claims 2 and 22 depend from claims 1 and 13, respectively, which were rejected over Larson and Tanaka; and (2) the Office Action fails to specify the features of Tanaka that are believed to correspond to the features of the claims. Therefore, Applicant respectfully traverses the rejection of claims 2 and 22 based only on Larson and Kawakami.

Claims 2 and 22 variously depend from claims 1 and 13, and thus would not have been rendered obvious by Larson or Kawakami for at least the reasons discussed above with

respect to claims 1 and 13, as well as for the additional features they recite. Accordingly, reconsideration and withdrawal of the rejection of claims 2 and 22 are respectfully requested.

B. Claims 10 and 20

The Office Action asserts that Larson teaches the claimed invention except for at least two projections on each arm. However, the Office Action asserts that it would have been an obvious matter of design choice to provide multiple projections on each arm because it appears that the invention taught by Larson would perform equally well with two projections on each arm. Notwithstanding this assertion, Applicant respectfully submits that such assertion does not establish a prima facie case of obviousness.

MPEP 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on [A]pplicant's disclosure or the mere fact that components at issue are functional or mechanical equivalents.

Larson does not teach or suggest two projections provided on each arm. Further, the Office Action has not identified any evidence that the art would have recognized the equivalence alleged above. Therefore, such allegation appears to be improperly based on Applicant's own disclosure, which is impermissible hindsight reasoning.

Claims 10 and 20 also variously depend from claims 1 and 13, and thus would not have been rendered obvious by Larson for at least the reasons discussed above with respect to claims 1 and 13 and MPEP 2144.06, as well as for the features they recite. Accordingly, reconsideration and withdrawal of the rejection of claims 10 and 20 are respectfully requested.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-15 and 17-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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